

Remarks

Status of Claims

Upon entry of this amendment, claims 1, 2, 5, 6, 10 and 11 are pending. Claims 6 and 10 are withdrawn. Claims 1, 2 and 5 have been amended. Claim 11 is new, and claims 3, 4, 8 and 9 have been cancelled without prejudice or disclaimer.

Claims Amendments:

Claims 1 and 2 have been amended to include the embodiments of the now cancelled claims 3 and 4. These amendments do not add new matter. Support for the amendments is found in the original claims as filed and in Tables 1 and 2 of the specification as filed. By way of example, the tables below give the respective claim elements and the example:

R ¹	Example
halo	1-31, 33-48, 50-60, 62-115, 117-120, 122-130, 132-134, 136-145, 147-326
methyl	32, 49, 61, 116, 121, 131, 135, 146,
trifluoromethyl	35, 47, 51, 64, 87, 99, 103, 119, 132,

R ²	Example
phenyl	1-107, 111, 112, 120-123, 125, 126, 129-136, 140-149, 151-176, 178-188, 190, 192, 194-204, 206-208, 210-238, 240, 241, 243-298, 300-326
benzo[1,3]dioxolyl	108, 115-119, 205
cyclopentyl	239, 242
benzoxazolyl	109, 110, 128
benzthiazolyl	124
2,3-dihydro-benzo[1,4]dioxinyl	113
2,3-dihydro-benzofuranyl	114, 139
1H-indazolyl	127
1H-indolyl	137, 138, 189, 191, 193
naphthyl	150, 177, 209
2-oxo-2, 3-dihydro-1H-indol-5-yl	299

R ² substituents	Example
halo	7, 12, 22, 38-40, 60-64, 74-79, 87-89, 105, 106, 109, 123, 125, 126, 129, 145-149, 164, 165, 167, 179, 194, 196, 206, 210, 211, 221, 317-319

hydroxy	1, 8-10, 26
methoxy	12, 13, 65, 73, 120, 123, 164, 221
trifluoro-methoxy	100
difluoro-methoxy	14, 112
ethyl	110, 111, 128
methyl-sulfanyl	134-136, 208
methyl-carbonyl-amino	24, 162
formamidyl	27
trifluoro-methyl	120
methyl	4, 6, 11, 31-36, 49-51, 59, 88, 89, 101-104, 109, 121, 125, 126, 145-147, 167, 194, 211, 252
amino-carbonyl	27
dimethyl-amino	5, 227, 235
methyl-sulphanyl	134-136, 208
methyl-formamidyl	290, 326
methyl-carbonyl	287, 302, 306
ethenyl	289, 300, 304, 316
methoxy-carbonyl	190, 192, 226
isopropyl	286, 301, 305
isopropoxy	90-92, 99, 195
cyano-methyl	251
optionally substituted phenyl	2, 15-21, 23, 28, 41-44, 52-58, 66-68, 71, 72, 82-86, 94, 95, 130-133, 140-144, 154-160, 168-171, 173, 174, 182-188, 197-204, 213-219, 229-234, 243-250, 253-256, 258-267, 270-274, 276-285, 291-298, 308-312, 314, 320, 323-325
optionally substituted isoxazolyl	81, 166, 176, 180
optionally substituted pyrazolyl	80, 172, 175, 178, 181, 223, 288, 303, 315
optionally substituted phenoxy	152, 163, 212
optionally substituted phenyl-carbonyl	122
optionally substituted pyridinyl	69, 275, 307, 321
optionally substituted 1H-indolyl	93, 228
optionally substituted pyrimidinyl	29, 30, 70, 222, 224, 225
optionally substituted thiophenyl	268, 269
optionally substituted benzoxy	3, 37, 45-48, 96-98, 107, 236, 237
optionally substituted furanyl	25, 257
optionally substituted 2, 3-dihydro-benzo[1,4]dioxinyl	153
optionally substituted [1,3]dioxolanyl	151
1-oxo-1,3-dihydro-isobenzofuran-5-yl	220
optionally substituted benzo[1,3]dioxolyl	313

Optional substituents of R ² substituents	Example
halo	53, 82, 86, 95, 173, 187, 188, 197, 198-202,

	204, 213, 215-217, 229, 240, 247, 248, 253, 263, 272, 273, 277, 280-282, 310
methyl	29, 81, 84, 85, 174, 184, 199, 214-216, 218, 222, 224, 225, 257, 268, 269, 276
cyano	55, 97, 98, 254, 267
carboxy	3, 274, 282, 298
carboxy-methyl	236
cyano-methyl	283
methoxy	2, 15, 17, 71, 82, 96, 173, 174, 184, 188, 202, 218, 238, 256, 258, 262, 276, 277, 281, 307, 308, 310-312, 314, 320, 321, 324, 325
methoxy-methyl	16
hydroxy-methyl	19-21, 42, 245
t-butoxy-carbonyl-amino	23
methyl-carbonyl-amino	231, 234, 243, 246, 255
methoxy-carbonyl	28, 140, 233, 243
phenyl	41, 43, 207
t-butyl	44
butyl	52
isopropyl	54
methyl-sulfonyl-amino	56
hydroxy	57, 94, 186, 259, 314, 325
cyclopropyl-formamidyl	58, 83, 264
methoxy-methyl-amino-carbonyl	66, 279
cyclopentyl-formamidyl	67, 265, 266
2-methoxy-propionyl	68
dimethyl-amino-carbonyl	72, 155, 278
phenyl-sulfonyl	93, 228
methyl-sulfonyl	107, 284
ethoxy-carbonyl	141, 244
t-butoxy-carbonyl	142, 143
methyl-sulfonyl-amino	144, 249
phenoxy	18, 322
methyl-amino-carbonyl	154, 231, 291
diethyl-amino-carbonyl	156, 292
t-butyl-amino-carbonyl	157, 293
isobutyl-formamidyl	158
formamidyl	159, 261
pyrrolidinyl-carbonyl	160
benzyl-formamidyl	168, 294
morpholino-carbonyl	169, 260, 270
ethyl-formamidyl	170, 296
methoxy-carbonyl-ethyl	171
benzyl	172

butoxy	182, 185
ethoxy	183, 200, 203
trifluoro-methyl	217
ethoxy-carbonyl-methyl	219
amino-sulfonyl	229
chloro-methyl-carbonyl-amino	230
2-oxo-piperidin-1-yl	232
ethyl	234, 241
ethanoic acid	236
1-methylethanoic acid	237
trifluoro-methoxy	271, 297, 309, 323
hydroxy-carbonyl	274
methyl-carbonyl-amino-methyl	285
4-oxo-piperidin-1-yl-carbonyl	295
acetyl-amino	231, 234, 243, 246, 255

R ³	Example
<i>t</i> -butyl	1-37, 41-316, 320-326
1,1-dimethyl-butyl	38
methyl-cyclopentyl	39
1,1-dimethyl-propyl	40
1,1-dimethyl-2-methyl-propyl	317
methyl-cyclohexyl	318
1-ethyl-1-methyl-propyl	319

Restriction/Election Requirement:

The Examiner has required a Restriction/Election under 35 U.S.C 121 and 372.

Specifically, the Examiner has required an election from (see Office Action, page 2):

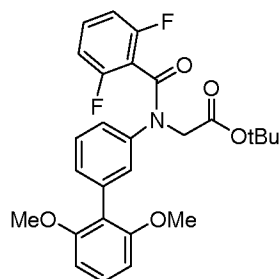
Group I (claims 1-5): drawn to compounds of Formula (I) and compositions thereof,

or

Group II (claims 6, 7, 9 and 10): drawn to methods of treatment.

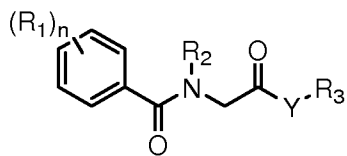
For each group an election of a single species was requested.

The Applicants herein provisionally elect Group I with traverse and elect the compound depicted in Example 2 as the single species election:



Example 2

With respect to Formula (I), the compound depicted in Example 2 corresponds to the following:



wherein,

Y is O;

R¹ is fluoro (halo);

R² is phenyl substituted with an optionally substituted phenyl wherein the optional substituents are methoxy, and

R³ is t-butyl;

The claims encompassing the elected group are claims 1, 2, 5, 6, 10 and 11.

Restriction/Election with Traverse:

The Applicants respectfully disagree with the Restriction/Election Requirement, wherein the Office Action asserts that (see Office Action pages 2-3):

“Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The only element that can provide the required special technical feature are the compounds of Formula I. The compounds of Formula I are not novel as demonstrated by Hopwood (US 5,110,348, 05-1992, Table 1, columns 7-10, cited in the search report) who discloses a large number of compounds of Formula I. Formula I compounds cannot, therefore, provide the required special technical feature and unity is lacking.”

The Applicants respectfully disagree that Hopwood (US 5,110,348) anticipates each and every element of Applicants compounds of Formula (I). Accordingly, the Applicants respectfully request withdrawal of the Restriction/Election requirement.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants believe all claims now pending in this Application are in condition for allowance. It is believed that no fees are necessary in connection with this paper, however if this is incorrect and additional fees are due, or additional extensions of time are necessary to prevent abandonment of this application, then the U.S. Patent and Trademark Office is authorized to deduct any requisite fees from, or deposit any overpayment into, Deposit Account No. **50-1885** referencing docket PAT033827-US-PCT (formerly P1140US10).

If the Examiner believes a telephone conference would expedite prosecution of this application, the Examiner is respectfully requested to contact the undersigned at the telephone number below.

Respectfully submitted,

Date: April 1, 2010

/Daniel E. Raymond, Reg. # 53,504/

Daniel E. Raymond

Daniel E. Raymond, Ph.D.

Agent for the Applicants, Reg. No. 53,504

The Genomics Institute of the Novartis Research Foundation

10675 John Jay Hopkins Drive

San Diego, CA 92121

Customer No.: 29490

Phone: (858) 812 1617

Fax: (858) 812 1909